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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARCIA BUISER, PAUL DICARLO, THOMAS V. CASEY II,
ERIN MCKENNA, and ROBERT F. RIOUX

Appeal 2011-002712
Application 10/830,195
Technology Center 1600

Before ERIC GRIMES, FRANCISCO C. PRATS, and STEPHEN WALSH,
Administrative Patent Judges.

WALSH, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) involving claims to a composition comprising a particle chain. The Patent Examiner rejected the claims on grounds of obviousness and non-statutory obviousness-type double patenting. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

“The invention relates to embolization.” (Spec. 1, l. 2.) According to the Specification, “[c]ompositions including embolic particles are used for occluding vessels in a variety of medical applications.” (*Id.* at ll. 5-6.)

Claims 1-4, 11, 23-31, 49-53, 60, 62, and 63, which are all the pending claims, are on appeal. Claim 1 is representative and reads as follows:

1. A composition, comprising:

a particle chain having at least two connected particles and a link that connects the at least two connected particles, wherein:

the at least two connected particles and the link are integrally formed of PVA;¹

at least one of the at least two connected particles has an interior region with pores having a first mean size, a surface region with pores having a second mean size, and a body region between the interior region and the surface region, the body region with pores having a third mean size, the third mean size being greater than the second mean size,

the first mean size is about 20 microns or more;

the second mean size is about one micron or less;

the third mean size is about 18 microns or less;

the link has an aspect ratio of at most about 1,000 and the link has an aspect ratio of at least about 0.001;

a ratio of the diameter of one of the at least two particles to a width of the link is at least about 0.5 and the ratio of the diameter of one of the at least two particles to a width of the link is at most about 100;

the link has a length of at least about one micron and wherein the link has a length of at most about 50,000 microns; and

the link has a width of at most about 0.01 inch and the link has a width of at least 0.001 inch.

¹ Polyvinyl alcohol.

The Examiner rejected the claims as follows:

- claims 1-4, 11, 23-31, 49-53, 60, 62 and 63 under 35 U.S.C. § 103(a) as unpatentable over Jacobsen,² Greene,³ and Lanphere ‘895;⁴
 - claims 1-4, 11, 23-31, 49-53, 60, 62 and 63 on the ground of nonstatutory obviousness-type double patenting as unpatentable over the claims of U.S. Patent No. 7,131,997; 7,449,236; 7,462,366; 7,588,780 and 7,611,542 in view of Jacobsen and Greene; and
 - claims 1-4, 11, 23-31, 49-53, 60, 62 and 63, provisionally, on the ground of nonstatutory obviousness-type double patenting as unpatentable over the claims of U.S. Application Serial No. 12/235,978, 12/236,051 and 10/651,475 in view of Jacobsen and Greene.

Claims 2-4, 11, 23-31, 49-53, 60, 62 and 63 have not been argued separately and therefore stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

OBVIOUSNESS

The Issue

Appellants summarize their position as follows:

[A]ssuming solely for the sake of discussion, that it would have been obvious to one skilled in the art to try to combine the references in the manner indicated by the Examiner, the Examiner has failed to demonstrate how the references could have been combined. Thus, the obviousness rejection is

² Stephen C. Jacobsen et al., US 6,530,934 B1, issued Mar. 11, 2003.

³ George R. Greene, Jr., et al., US 2002/0177855 A1, published Nov. 28, 2002.

⁴ Janel Lanphere et al., US 2003/0185895 A1, published Oct. 2, 2003.

improper because the Examiner has not demonstrated that the asserted combination of Jacobsen, Greene and Lanphere would have enabled one skilled in the art to make the subject matter covered by the claims.

(App. Br. 3.) According to Appellants, neither Jacobsen nor Lanphere even disclose a process for joining particles, and the processes disclosed by Greene would not work for Appellants' subject matter, "at least because the claimed subject matter requires the link and the at least [two] particles to be integrally formed of the same material." (*Id.* at 4.)

The Examiner responds that the Jacobsen patent disclosed and claimed that the filament and bead were integrally formed, and a patent is presumed enabled. (Ans. 12.) The Examiner also emphasized that "Greene teaches similar porous micropellets affixed to a carrier, including use of PVA as both micropellet and carrier." (*Id.*)

Findings of Fact

1. We adopt the Examiner's findings. (Ans. 4-13.)
2. The Examiner found that "[Jacobsen's] beads may be integrally formed of the material of the filament (column 4, line 24.)" (*Id.* at 5.)
3. Jacobsen taught: "[t]he fixed beads may even be integrally formed of the material of the filament." (Jacobsen, col. 4, ll. 23-24.)
4. Appellants' Brief refers generally to Greene's processes of making a filamentous embolization device, but does not identify the processes. (App. Br. 4.)
5. Greene's abstract reads in part: "Exemplary methods for making these devices include skewering and molding the embolizing elements." (Greene, Abstract.)

Principles of Law

An obviousness rejection under 35 USC § 103 of a composition claim is improper in “the absence of a known or obvious process for making the claimed compounds.” *In re Hoeksema*, 399 F.2d 269, 274 (CCPA 1968).

In patent prosecution the examiner is entitled to reject application claims as anticipated by a prior art patent without conducting an inquiry into whether or not that patent is enabled or whether or not it is the claimed material (as opposed to the unclaimed disclosures) in that patent that are at issue. *In re Sasse*, 629 F.2d 675, 681, 207 USPQ 107, 111 (C.C.P.A. 1980) (“[W]hen the PTO cited a disclosure which expressly anticipated the present invention ... the burden was shifted to the applicant. He had to rebut the presumption of the operability of [the prior art patent] by a preponderance of the evidence.” (citation omitted)). The applicant, however, can then overcome that rejection by proving that the relevant disclosures of the prior art patent are not enabled. *Id.*

Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1355 (Fed. Cir. 2003) (footnote omitted). See also, *In re Paulsen*, 30 F.3d 1475, 1481 n.9 (Fed. Cir. 1994).

Analysis

The evidence supports the Examiner’s finding that Jacobsen taught a particle chain having beads integrally molded of the same material as the connecting filament. (FF 2, 3.) That finding was sufficient to shift the burden to Appellants to rebut Jacobsen’s presumed enablement by a preponderance of evidence. See *Amgen*, 314 F.3d at 1355. Appellants direct attention to Greene’s methods, which include molding. (FF 5.) There is no evidentiary support offered for Appellants’ argument that Greene’s methods would not work.

Appellants responded to the rejection with attorney argument against the teachings of both references, but no evidence. Attorney argument in a brief cannot take the place of evidence. On this record, the preponderance of the evidence supports a conclusion of *prima facie* obviousness.

NONSTATUTORY OBVIOUSNESS-TYPE DOUBLE PATENTING

The Examiner entered two rejections. The first rejected all the appealed claims over the claims in five issued patents combined with Jacobsen and Greene. The second is a provisional rejection of all appealed claims over the claims in three copending applications combined with Jacobsen and Greene.

Appellants “request reconsideration and reversal of each of the obviousness-type double patenting rejections in view of the arguments presented in the preceding section [addressing the obviousness rejection over Jacobsen, Green, and Lanphere ‘895].” (App. Br. 5.)

The arguments presented in the Brief’s preceding section were not persuasive of nonobviousness, and are likewise not persuasive of error in these rejections. We therefore affirm the double patenting rejections.

SUMMARY

We affirm the rejection of claims 1-4, 11, 23-31, 49-53, 60, 62 and 63 under 35 U.S.C. § 103(a) as unpatentable over Jacobsen, Greene, and Lanphere ‘895.

We affirm the rejection of claims 1-4, 11, 23-31, 49-53, 60, 62 and 63 on the ground of nonstatutory obviousness-type double patenting as

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unpatentable over the claims of U.S. Patent No.7, 131,997, 7,449,236, 7,462,366, 7,588,780, and 7,611,542, in view of Jacobsen and Greene.

We affirm the rejection of claims 1-4, 11, 23-31, 49-53, 60, 62 and 63, provisionally, on the ground of nonstatutory obviousness-type double patenting as unpatentable over the claims of U.S. Application Serial No. 12/235,978, 12/236,051, and 10/651,475, in view of Jacobsen and Greene.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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